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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,942	04/12/2001	Lawrence J. Mann	56319USA3A	3232

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EXAMINER

SALVATORE, LYNDIA

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/833,942

Applicant(s)

MANN ET AL.

Examiner

Lynda M Salvatore

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26, 28-33 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 and 38-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 23-26, 28-33 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicant's amendment and accompanying remarks, Paper No. 6, have been entered. Claims 23 and 31 have been amended and claims 27 and 34 have been cancelled. Despite this advance, Applicant's amendments are not found to patentably distinguish the claims over the prior art and Applicant's arguments are not found persuasive of patentability set forth herein below.

Election/Restrictions

2. Applicant's election without traverse of Group I, species claims 23-37 in Paper No. 6, is acknowledged. This application contains claims 1-22 and 38-47 drawn to nonelected invention. A complete reply to this Final Rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP 821.01.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The cancellation of claims 27 and 34 renders moot the 35 U.S.C. 103(a) set forth in section 10 of the last Office Action
5. Claims 23-26, 28-33, and 35-37 stand rejected under 35 U.S.C. 103(a) as obvious over Beardsley et al., US 5,849,051, in view of DeFilippi, US 5,580,770 and further in view of Recker et al., US 5,627,222 as set forth in section 10 of the last Office Action.

Applicant amended claims 23 and 31 to include a glass transition temperature range, however it is the position of the Examiner that the prior art references teaches known binders having the claimed glass transition temperature range. The Applicant argues that it is

inappropriate to combine the references of Beardsley et al., DeFilippi, and Recker et al., because each comes from nonanalogous art. This argument is not found persuasive on the grounds that the primary reference of Beardsley et al., meets the structural limitations set forth by the Applicant. Recall that Beardsley et al., teaches a abrasive foam article comprising a flexible resilient foam substrate having first and second surfaces, wherein at least one surface side further comprises a plurality of abrasive particles adhered to said surface with an adhesive binder (Abstract and Column 3, 37-42) The particles are distributed in a uniform manner along the surface and thin uniform coat of binder adhesive covers the abrasive particles (Column 5, 20-37 and Column 9,65-Column 10,13). The foam abrasive article is suitable for use in a variety of applications such as finishing and polishing metal, wood, and plastic (Column 2, 15-20). As such, it is the position of the Examiner that it is proper to look to the prior art to teach the claimed physical property features (i.e., glass transition temperature, shore A and D hardness, or the aspect ratio).

With regard to the glass transition temperature, Beardsley et al., teaches the use of a variety of suitable binders, but is silent with respect to the glass transition temperature of said binders. In this instance, the Examiner provided the reference of DeFilippi to evidence that the glass transition temperature is used to correlate the structure of the binder to its ability to function as an effective binder and that a binder having the claimed glass transition is known. The Examiner did not look to DeFilippi to provide motivation for using a binder, but rather to teach known binder properties.

With regard to the shore A and D hardness and aspect ratio, Beardsley et al., teaches using abrasive organic particles such as diamond, silicon carbide as well as less aggressive

thermoplastic particles. Again the Examiner looked to the prior art of Recker et al., to evidence that rubber-comprising particles have low glass transitions temperatures and exhibit good adhesion, not to provide motivation for using less aggressive particles.

To these ends, the Examiner maintains that the Shore A and D hardness, and the aspect ratio recited in claims 23,25,30 and 31, must be inherent to the functionalized rubber particles of Recker et al. Support for said presumption is found in the use of like materials such as thermoplastic or nitrile rubber particles and use of like processes such as forming sphere shaped particles, which would result in the claimed property. The burden is shifted to the Applicant to evidence the contrary.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

ls
May 30, 2003


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
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